

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
August 4, 2005

Mailed:
January 10, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Johnson & Johnson

v.

Natural Thoughts, Inc.

Opposition No. 91122373
to application Serial No. 75923257
filed on February 18, 2000

Stephen J. Meyers, John Chesney and Philip Abromats of
Drinker Biddle & Reath LLP for Johnson & Johnson.

Gabor L. Szekeres for Natural Thoughts, Inc.

Before Seeherman, Zervas and Walsh, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Johnson & Johnson has opposed the application of
Natural Thoughts, Inc. to register DUAL-PURPOSE MASSAGE
CREME as a trademark for massage creme.¹ As grounds for
opposition, opposer has alleged that it has used the mark

¹ Application Serial No. 75923257, filed February 18, 2000, and
asserting first use and first use in commerce on May 10, 1986.

Opposition No. 91122373

PURPOSE for toilet soap and hair shampoo since 1972, and for a moisturizer for use on the face and elsewhere on the body since 1978; that it owns registrations for PURPOSE for such goods, as well as other marks having the word PURPOSE in them; that applicant's use of DUAL-PURPOSE MASSAGE CREME for its identified goods is likely to cause confusion or mistake or to deceive; and that applicant has previously been denied registration of the mark DUAL-PURPOSE for massage crème in an opposition proceeding brought before this Board.

Applicant has admitted that it was denied registration of the mark DUAL-PURPOSE, but has otherwise denied the salient allegations of the notice of opposition. Applicant has also asserted the affirmative defenses of laches and acquiescence.

Before discussing the record, we must address two motions of applicant. The first motion is to strike, on the ground of fraud, opposer's reply trial brief and its brief in opposition to applicant's motion to exclude opposer's rebuttal testimony. With respect to the reply trial brief, applicant questions the accuracy of the date of service that opposer's counsel placed on the brief, noting that the date placed on the brief was January 19, 2005, while the postmark date on the envelope was January 24. Applicant questions opposer's counsel's declaration explaining the steps he took in connection with the mailing of the brief, asserting, for

example, that it is not credible that opposer's counsel did not know how to operate the firm's postage meter; that no one else was available in the offices who did know how to operate it, no matter how late the time; and that counsel happened to have in his possession the postage stamps necessary to mail the brief to applicant. Applicant also considers it unlikely that a post office in the downtown business district of Philadelphia would take until January 24 to process a piece of mail that was deposited on January 19. Applicant argues that the combination of these events is so unlikely that we should conclude that the brief was not, in fact, deposited in the mail on January 19, 2005, and that the certificate of service was false. Applicant further asserts that such false certification should be sanctioned by striking the brief.

We cannot, on the record herein, find that opposer's counsel fraudulently asserted an earlier service date for its reply brief. First, there is no question that opposer had prepared its reply brief on January 19, as it was filed electronically on this date at the USPTO, and Office records confirm the filing. In view thereof, there does not appear to be a good explanation as to why opposer's counsel would not serve a copy of the brief on applicant at the same time. As to applicant's charges, we do not consider it remarkable that an attorney would not know how to operate an office

postage meter, or that at a very late hour there would not be litigation support staff available that would know how to operate it.² Nor do we think it is particularly telling that there might be a five day delay between the time a piece of mail is placed in a mail box and the date it is postmarked. It is common knowledge that the Postal Service can misplace or even permanently lose letters; that is one of the reasons that the USPTO instituted the certificate of mailing procedure which is now found in Trademark Rule 2.197.

Finally, we note that there was no prejudice to applicant from the delay in receiving the reply brief. No papers may normally be filed in response to a reply brief. Accordingly, the motion to strike opposer's reply brief is denied.

Applicant has raised similar points with respect to opposer's brief in opposition to applicant's motion to strike rebuttal testimony. With respect to the credibility issues applicant has raised, our position is the same as that set forth above. As with opposer's reply brief, the Office records show that opposer's brief was timely filed,

² We note that opposer's counsel does not specifically state whether there was anyone else working at the firm at the time he wanted to use the postage meter. Given that the use of postage stamps was an acceptable alternative to a postage meter, it was not necessary for opposer's counsel to state whether anyone, even someone outside of the litigation department, may have been present at the firm at that time.

so it is clear that opposer was not attempting to deliberately misstate the date of service in order to "backdate" its paper. Applicant has also pointed out that there is a misstatement in the certificate of service for the brief, in that it states that it was being served on January 19, 2005 by facsimile and by first class mail, when in fact it was not served by facsimile. Opposer's counsel has stated that the inclusion of the words "by facsimile" was the result of a clerical error. The document was served only by first class mail. On January 21, 2005, opposer filed a "corrected" brief (actually a redacted, public version of its brief), along with a notice of the filing of this paper. The notice of filing bore a certificate of service which indicated that on January 21, 2005 the brief was being served by overnight courier as well as first class mail, when in fact the notice was not served by courier. Opposer's counsel has submitted a declaration in which he explained that he had originally intended to serve the brief by courier and then changed his mind, but that the reference to the courier was inadvertently left in the certificate.

Although it is expected that counsel would carefully read a certificate of service so that what is said in the certificate conforms with what is actually done, there is no requirement that papers be served by facsimile or by overnight courier. Therefore, opposer complied with the

rules by serving the papers by first class mail. As for the clerical errors in the certificates of service, they do not rise to the level of fraud, and we do not think that any sanction with respect to these misstatements is warranted. Accordingly, applicant's motion to strike the briefs in opposition to applicant's motion to exclude is denied.

This brings us to applicant's motions to exclude the rebuttal testimony of Julia Sankey and Daphne Hammond. Julia Sankey is an employee of a private detective agency. She had previously testified, during opposer's case in chief, about her investigation as to whether massage products and skin care products were sold in the same retail establishments and through Internet websites. In her rebuttal testimony, she provided her findings as to whether personal care products that included massage products, and skin care products, were sold under the same brand. Ms. Hammond, whose company performs trademark research, testified that she conducted a search of the USPTO's database to find trademark registrations in which the identification of goods included massage cream, and she provided copies of registrations whose identifications included massage cream and other types of cosmetics and toiletries.

Applicant contends that this testimony is not proper rebuttal because, to the extent it is relevant, it should

have been part of opposer's case in chief. Applicant asserts that applicant, during its case in chief, did not elicit any testimony regarding the issues about which opposer's rebuttal witnesses testified.

Opposer, in response, states that the two testimony depositions were justified in order to rebut a single response given by applicant's witness Monica Fraser:

Q: And based on your experience and knowledge of the business as the president of the company that sells this type of personal care product, why is it your opinion that there was no--that, to your knowledge, there was no confusion, mistake ever about the source of the product, your product with the Johnson & Johnson Purpose product?

A: They're two completely different products and they're different markets.³

Opposer, citing *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980), states that as long as it has made out a prima facie case during its testimony in chief, it may submit during its rebuttal period evidence for the purpose of denying, explaining or discrediting the

³ Quoted at p. 2 of opposer's brief in opposition. It is noted that the answer appears in the confidential brief filed by opposer, but not in the public version. When opposer initially filed its brief it did not do so under seal, which necessitated the filing of the "corrected" brief mentioned in our above discussion of the previous motion. Opposer has explained that nothing confidential appears in this response, but that it treated the response as confidential because the entire deposition of Ms. Fraser was filed under seal. In fact, although Ms. Fraser's entire deposition was filed as confidential, applicant also filed a redacted "public" copy. The exchange quoted above appears in the public version, and we have therefore quoted it in our opinion.

facts and witnesses offered by applicant. Opposer has quoted the following language from the opinion:

[I]f plaintiff has made out a prima facie case for relief during its testimony-in-chief, it may introduce, during its rebuttal period, evidence for the purpose of denying, explaining or discrediting the facts and witnesses offered by the defendant, notwithstanding that this rebuttal may serve to strengthen its case-in-chief. However, if a prima facie case has not been established during the regular trial period, the plaintiff ... cannot, through the guise of rebuttal, create a prima facie case or plug holes in its own case-in-chief which may have been overcome by defendant[.]

Id. at 93.

Opposer asserts that it has made a prima facie case of likelihood of confusion with its testimony-in-chief, and therefore it is permitted to submit additional evidence in rebuttal. Opposer is correct that a plaintiff may not use its rebuttal period to salvage a deficient case in chief. However, this does not mean that the converse is also true, i.e., that if its case in chief is not deficient, it may submit any evidence that it wishes to during its rebuttal period. The language quoted by opposer also points out that a plaintiff cannot, through the guise of rebuttal, plug holes in its own case-in-chief. Testimony that is properly part of a plaintiff's case-in-chief must be made of record during the plaintiff's case-in-chief. See *Hard Rock Cafe International (USA), Inc. v. Thomas D. Elsea*, 56 USPQ2 1504,

1508 (TTAB 2000). Plaintiffs would otherwise have an unfair advantage, because they could submit during their rebuttal testimony period evidence on new points that the defendant would not have an opportunity to counter. See *Osage Oil & Transportation, Inc. v. The Standard Oil Company*, 226 USPQ 905, n. 10 (TTAB 1985). For example, if opposer's position were to be adopted, a plaintiff that had not submitted any evidence on the du Pont factor of fame during its case-in-chief could submit such evidence during its rebuttal testimony period simply because the defendant's witness testified that he did not believe the plaintiff's mark is famous. See *Interstate Brands Corp. and Interstate Brands West Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, n. 4 (TTAB 2000):

...these articles constitute improper rebuttal. Proving fame was an element of opposer's case-in-chief. The only reference to the fame of opposer's mark which was made during applicant's testimony period was a question asked by opposer's attorney during the cross-examination of each of applicant's witnesses as to their belief as to whether HOHOs is a famous mark. Opposer cannot, simply by raising the question of fame on cross-examination, cure its failure to submit evidence which is clearly part of its case-in-chief.

See also, *Hard Rock Cafe International (USA), Inc. v. Thomas D. Elsea*, supra at 1508 (TTAB 2000) ("To the extent that the articles have been submitted to show the fame of opposer's mark, applicant's objections are well taken. Fame is an

element to be proved as part of opposer's case-in-chief, not during the rebuttal testimony period.")

On the other hand, it is proper to introduce during a plaintiff's rebuttal testimony period evidence that denies, explains or discredits facts and witnesses offered by the defendant. Opposer argues that the rebuttal testimony which is the subject of applicant's motion contradicts and discredits Ms. Fraser's testimony, while applicant takes the position that this testimony should properly have been part of opposer's case-in-chief.

It is sometimes difficult to determine whether evidence submitted during rebuttal should have been part of the plaintiff's case-in-chief or whether it is merely contradicting or explaining the defendant's evidence, and therefore is proper rebuttal. In the present case, however, we have no hesitancy in concluding that the evidence opposer seeks to make of record is not proper rebuttal. As noted, opposer claims that the rebuttal testimony was submitted solely to contradict Ms. Fraser's testimony as to why she believed there was no confusion about the source of applicant's product and opposer's product--that "they're two completely different products and they're different markets." The question and response were directed to applicant's product and opposer's product, not to massage creams and skin cleansers and moisturizers in general.

Thus, testimony about third parties that have used the same mark on both types of products or have registered a single mark for both types of products does not contradict or explain Ms. Fraser's testimony. Similarly, the statement that opposer and applicant sell their respective products in different markets is not contradicted or explained by evidence of third parties that sell or have registered both types of products under a single mark.

Opposer cites to *Finance Co. v. BankAmerica Corp.*, 205 USPQ 1016 (TTAB 1980), as having "circumstances almost identical to those present in this case." Brief in opposition, p. 6. In that case, the Board allowed the opposer to submit evidence regarding applicant's commercial financing operations as rebuttal to applicant, who had tried to "instill the impression in the trier of fact that applicant's commercial financing services do not exist and that the parties are not, in fact, competing in the commercial arena." *Id.* at 1022. Here, however, although applicant has submitted evidence as to the actual classes of customers and trade channels in which it sells its goods, the rebuttal testimony does not attempt to demonstrate that applicant in fact sells its goods in other channels of trade and to other customers, which would be analogous to the *Finance Co.* case; rather, the rebuttal testimony does not refer at all to the sales of applicant's product.

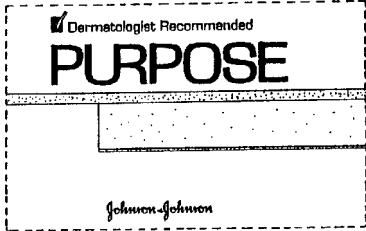
In short, the testimony of Ms. Sankey and Ms. Hammond that was taken during opposer's rebuttal testimony period is not proper rebuttal. Accordingly, we have not considered it in rendering our decision.

Finally, during the testimony depositions each party raised various objections to testimony and exhibits. Because these objections were not reiterated in the respective briefs on the case, or were not the subject of motions to strike, we have deemed them to be waived.

Thus, the record includes the pleadings; the file of the opposed application; the testimony, with exhibits, of opposer's witnesses Nicole McLaughlin, a product director at opposer for its PURPOSE brand, and Julia Sankey, an investigator, taken during opposer's testimony period; the testimony, with exhibits, of applicant's witnesses: Monica Fraser, applicant's president; Jean Shea, applicant's vice president (two separate depositions); Lorena Cornejo and Patricia Walden, applicant's employees; Roger Green, a dermatologist; Karen Kelley, Linda Wilson and Ruth Dorn, professional massage therapists; and Steven Lyons, the manager of a store that sells massage therapy products.

Opposer has submitted, under notice of reliance, status and title copies of its pleaded registrations, to wit:⁴

⁴ Opposer also pleaded ownership of, and submitted a status and title copy of, Registration No. 2250390, issued June 1, 1999, for PURPOSE SKIN CARE PRODUCTS in stylized form, (SKIN CARE PRODUCTS

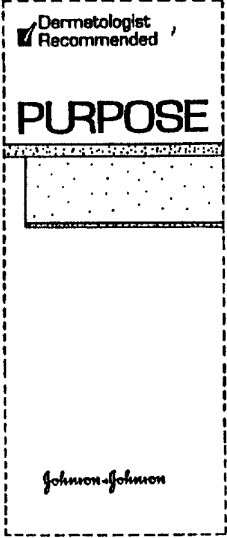
MARK	GOODS
PURPOSE	Toilet soap and hair shampoo ⁵
PURPOSE	Skin care products, namely a moisturizer for use on the face and elsewhere on the body ⁶
 <p>DERMATOLOGIST RECOMMENDED disclaimed. The stippling in the drawing is for shading purposes and does not indicate color.</p>	Skin cleanser and bath soap ⁷

disclaimed), for bath soap, skin cleansers, moisturizers, lotions and creams. There is no indication that a Section 8 affidavit has been filed for this registration. Therefore, although the registration has not been formally cancelled, we have not considered it in rendering our decision herein. In any event, as discussed infra, the status of this registration would have no effect on our decision.

⁵ Registration No. 977884, issued January 29, 1974; Section 8 & 15 affidavits accepted and acknowledged; renewed twice. (The second renewal occurred during the pendency of this proceeding, but after the Office prepared the status and title copy of this registration. In accordance with Board practice, we have taken judicial notice of the updated status of the registration.)

⁶ Registration No. 1549744, issued August 1, 1989; Section 8 & 15 affidavits accepted and acknowledged.

⁷ Registration No. 2244136, issued May 11, 1999; Section 8 & 15 affidavits accepted and acknowledged. (The filing and acceptance/acknowledgment of the Section 8 and 15 affidavits occurred during the pendency of this proceeding, but after the Office prepared the status and title copy of this registration. We have taken judicial notice of the updated status of the registration.)

 <p>DERMATOLOGIST RECOMMENDED disclaimed. The stippling in the drawing is for shading purposes and does not indicate color.</p>	<p>Skin cleansers, moisturizers, lotions and creams⁸</p>
<p>GREAT SKIN HAPPENS ON PURPOSE SKIN disclaimed</p>	<p>Bath soap, skin cleansers, skin moisturizers, skin lotions and skin creams⁹</p>

Applicant has submitted, under notice of reliance,
opposer's answers to certain of applicant's first and second
sets of interrogatories, supplemental responses, and

⁸ Registration No. 2265982, issued August 3, 1999; Section 8 & 15 affidavits accepted and acknowledged. (The filing and acceptance/acknowledgment of the Section 8 and 15 affidavits occurred during the pendency of this proceeding, but after the Office prepared the status and title copy of this registration. We have taken judicial notice of the updated status of the registration.)

⁹ Registration No. 2377888, issued August 15, 2000.

opposer's responses to certain of applicant's requests for admission.¹⁰

The parties have fully briefed this proceeding,¹¹ and were represented at an oral hearing held before the Board.

The evidence shows that opposer began using the mark PURPOSE in 1972, and has been using it for moisturizers since 1978 and for cleansers since 1989. It has also, in the past, used the mark for alpha hydroxy moisture creams and lotions and hair shampoos. The products are for general use on the face and neck, although opposer's product director testified that they could be used elsewhere on the body. Opposer's sales are national, with PURPOSE products being sold through food and drug stores such as CVS, Rite-Aid and Eckerd, and mass merchandisers such as Wal-Mart and Target. A very small percentage of sales are through Internet retailers such as Drugstore.com. Opposer advertises its PURPOSE moisturizers and cleansers through major beauty publications such as "Allure," "Self," "Redbook" and "Good Housekeeping"; direct-to-consumer initiatives; direct mail programs; and in-store promotions like displays, handouts of consumer education on the brand, circulars in the store, and coupons. Opposer also promotes

¹⁰ Opposer's counsel's letter dated January 7, 2002 is deemed to be a supplemental response to applicant's first set of interrogatories.

¹¹ As noted previously, applicant's motion to strike opposer's reply brief was denied, and the reply brief has been considered.

its products to dermatologists through samples, patient education materials and by attending and exhibiting at major dermatologist conventions.

Applicant began selling its DUAL PURPOSE MASSAGE CREME product in 1986. It is a massage lubricant used by professional massage therapists, and it is primarily sold to professional massage therapists, schools and students of massage therapy and distributors of massage therapy products. Applicant sells its product through telephone and mail orders, through its Internet website, to people who pick it up directly from applicant's premises, and through dealers in massage therapy products. Applicant advertises in publications directed to professional massage therapists, such as "Massage Therapy Journal" and "Massage and Bodywork."

Applicant chose the name DUAL PURPOSE MASSAGE CREME because it "seemed like a catchy name." Shea dep., p. 9. Before adopting the mark, applicant's then-President searched a book of registered trademarks, as well as USPTO Official Gazettes.

At the outset, we must point out that, despite the fact that applicant's goods are identified as "massage creme," the Examining Attorney never required applicant to disclaim the exclusive right to use this term in its mark. Because MASSAGE CREME is a generic term for applicant's goods, if

applicant should ultimately succeed in this proceeding, the application will be remanded to the Examining Attorney pursuant to Trademark Rule 2.131 to consider whether a disclaimer should be required. It should also be noted that the question of whether applicant's mark is merely descriptive is not before us. It was not raised as a ground by the opposer, and we also note that the Examining Attorney never raised this as a basis for refusing registration of the mark.¹²

This brings us to a consideration of the pleaded ground for opposition: likelihood of confusion. Because opposer has made of record its pleaded registrations, priority is not in issue. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the record shows that opposer began using its PURPOSE mark for moisturizer prior to applicant's use of DUAL-PURPOSE MASSAGE CRÈME for massage creme. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In*

¹² A review of the application file shows that the Examining Attorney approved the mark for publication upon her initial review of the file, and neither raised any refusals or made any requirements.

re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). .

Turning first to the goods, applicant has argued, and has submitted evidence, to show that opposer's cleansers and moisturizers are different from applicant's massage cream, and that opposer's products cannot be used as massage creams, and vice versa.¹³ However, the question is not whether consumers will confuse the goods, but whether they will confuse the source of the goods. Therefore, it is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case, one of the purposes of a massage cream is to moisturize. Applicant has admitted as much in one of its

¹³ Although applicant has identified the goods in its application as "massage creme," applicant has referred to its goods in its brief as "massage cream," and we will also use this more common spelling.

ads. The first sentence, shown in larger size bold type states:

Dual-Purpose Massage Creme leaves skin soft and moisturized with no greasy feel. Get all the benefits of oil and lotion—in one luxurious formula.

This point is emphasized three sentences later, where it is repeated in virtually the same words. Further, applicant's customer service representative Lorena Cornejo testified that one of the benefits of the product is that it moisturizes, and that moisturizing is "one of the important qualities that customers want" from a massage. p. 16.

Moreover, the product is advertised as containing aloe vera and Vitamin E, and Ms. Cornejo has testified that these are moisturizing elements. We also note that this same advertisement points out that the product is "equally suited for the face, feet and hands, as it is for full body massage." The moisturizer in opposer's Registration No. 1549744 is specifically identified for use on the face and elsewhere on the body.

In view of the fact that one of the functions of a massage cream is to moisturize, and that applicant's own literature touts the moisturizing ability of the massage cream, consumers may well believe that a company that makes a moisturizer also makes a massage cream. We therefore find that opposer's moisturizer and applicant's massage cream are

related goods, and that the factor of the similarity of the goods favors a finding of likelihood of confusion.

The next du Pont factor we consider is the channels of trade. Applicant focuses much of its argument on the fact that its massage cream is sold to professional massage therapists, that it is not available through consumer outlets, and that it is advertised only in periodicals directed to professional massage therapists. Applicant contrasts this with opposer's goods, which are sold in retail stores such as Wal-Mart and CVS, and which are promoted through general consumer magazines and are also recommended by dermatologists in their practices.

The problem with applicant's position is that applicant's identification of goods does not limit the channels of trade and marketing of its massage cream to professional massage therapists. "It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be." *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918

F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed"). Thus, we must assume that applicant's goods are sold in all channels that are appropriate for the sale of massage creams, and not merely the specific channels of trade in which applicant's products are, in fact, sold. In re Elbaum, 211 USPQ 639 (TTAB 1981).

Opposer has shown that both moisturizers and massage creams are sold in some of the same "bricks and mortar" retail outlets (K-Mart and Ricky's).¹⁴ Further, searches of various Internet websites show that both moisturizers and massage creams may be sold from the same websites. We recognize that Internet retailers may sell a wide variety of goods, and we further note that there is no evidence that a search for "massage creme" or "massage" will retrieve skin moisturizers or cleansers. (On the contrary, the search

¹⁴ Opposer's trademark investigator also testified to finding skin moisturizers and Palmer's Stretch Mark Massage Cream in several of the same stores. Because of the specialized nature of the latter product, we do not consider it to fall within the category of "massage cremes" as identified in applicant's application.

applicant's vice president did for such terms did not retrieve the latter items.) However, a search of the Sephora website lists, under the general category "Bath & Body" and the subcategory "body lotions & creams," various body lotions and "relaxing massage cream," while the website for Do I Look Hot? lists, under the category skin care, Aveeno Daily Moisturizing Lotion, Vaseline Dry Skin Lotion and applicant's product. Further, the record shows that a search for "Purpose" in the "Health & Personal Care" section of amazon.com retrieved both opposer's PURPOSE moisturizer and cleanser and applicant's massage cream. In addition, a search by applicant's vice president of the amazon.com website for "Purpose" in the Health & Personal Care category, which retrieved many pages, shows opposer's PURPOSE cleansing wash not only on the same page, but immediately above applicant's massage cream (listed as BIOTONE Dual Purpose Massage Cream.) Based on the foregoing evidence and similar evidence made of record by opposer, we find that moisturizers and massage creams may be sold through the same Internet websites and in circumstances under which a consumer may encounter both types of products during a single search, and may even retrieve both opposer's and applicant's specific products on a single search results page.

Moreover, because massage creams are found in general retail stores, we must assume that such goods may be purchased by members of the general public, and not only by professional massage therapists. Certainly there is no evidence that massage products are bought only by professionals. On the contrary, we note that although applicant directs its marketing to the professional arena, applicant acknowledges that some of its massage products are bought by the general public. Members of the general public are also purchasers of skin moisturizers and cleansers. In this connection, although applicant has asserted that opposer's customers purchase its products only after they are recommended to them by dermatologists, there is no such limitation in opposer's registrations, and the presence of opposer's products in general retail stores shows that any consumer may buy them as "off-the-shelf" items.

Thus, we find that both parties' goods are sold in the same channels of trade to, in part, the same class of consumers, and this du Pont factor favors opposer.

Applicant has argued that the purchasers of its products, i.e., professional massage therapists, are knowledgeable and careful. However, the evidence shows that massage creams, as well as moisturizers and cleansers, can be purchased by the public at large. This class of consumers for the parties' goods cannot be considered

particularly knowledgeable or sophisticated. Further, neither parties' products are particularly expensive (the amazon.com listings submitted by applicant show opposer's products to cost under \$10, and applicant's to cost \$6). These are not the type of products that are likely to be purchased with the exercise of a great deal of care. Therefore, this factor also favors opposer.

We now turn to the factor of fame. Opposer has not claimed that its mark is famous, and the sales and advertising information provided by opposer falls far short of showing fame.¹⁵ Nor do we find this mark to be a particularly strong mark. Although opposer asserts that its mark is arbitrary for its goods, the record, and particularly the searches of Internet retailers for the term "Purpose," show that many third parties use this term either as part of their marks or to describe their products, as part of the phrases "Multi-Purpose" or "All-Purpose." See, for example, exhibit 3 to Sankey deposition: ReNu MultiPlus Multi-Purpose Solution, No-Rub Formula; Opti-Free Express Lasting Comfort, No-Rub, Multi-Purpose Disinfecting Solution; AMO Complete, Multi-Purpose Solution Value Pack; Buf-Puf Facial Sponge, Gentle, All-Purpose; Nexcare All Purpose Mask; AMBER All Purpose Cold Wax Kit; Conair Multi

¹⁵ We have not indicated the figures because this information has been marked "Confidential" and filed under seal.

Purpose Massager with Magnets; GIGI All Purpose Honee Wax. Because of the small size of the products as depicted in the search results exhibits, we cannot determine whether the term "All Purpose" or "Multi-Purpose" is actually part of the respective trademarks or is merely used as part of the description of the product, but the common usage of this phrase in the health and beauty field indicates that opposer's PURPOSE mark is not entitled to such a broad scope of protection that opposer should be able to prevent the registration of any other mark simply because it, too, contains the word "Purpose." Rather, the evidence of third-party use suggests that the public distinguishes between various marks containing this word by looking to other distinctive parts of those marks, e.g., ReNu, Opti-Free, AMO, Buf-Puf, Nexcare, AMBER, Conair, GIGI.¹⁶

With this in mind, we turn to a consideration of the parties' marks. Opposer's mark is PURPOSE; applicant's mark is DUAL-PURPOSE MASSAGE CREME. Applicant's goods are identified as "massage creme," and therefore the words

¹⁶ We note that applicant has also made of record pages showing that a search of "purpose" through the Google search retrieved 43 million hits, and a search of this word through the Yahoo search engine retrieved over 77 million hits. This evidence has virtually no persuasive value, as it merely shows that the word "purpose" was found somewhere in the listings that were retrieved, with no distinction being drawn between use as an ordinary word or name and as a trademark. For example, one listing is for a person named Darryl Purpose, another is a reference to someone who offers "life purpose coaching," and another is the title of an article, "The Purpose of Copyright."

MASSAGE CREME in applicant's mark are a generic term for the goods, and have no source-indicating value. Consequently, we give greater weight to the DUAL-PURPOSE portion of applicant's mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety.)

The dominant part of applicant's mark, thus, is DUAL-PURPOSE, which of course appropriates opposer's mark in its entirety. Accordingly, there are obvious visual and phonetic similarities. With respect to the connotations of the marks, there are certain differences, in that DUAL-PURPOSE can be viewed as having a meaning of two aims or functions, while the word PURPOSE per se has meanings in addition to goals or aims, e.g., "determination," "resolution."¹⁷ Overall, however, we do not find these differences, and especially the addition of the word DUAL, which if not descriptive is, at the very least, highly

¹⁷ The American Heritage Dictionary of the English Language, © 1970.

suggestive, to be sufficient to distinguish applicant's mark from the mark PURPOSE.¹⁸ Accordingly, we find that the marks are similar in commercial impression, and that this factor favors opposer.

We would also point out that applicant's witnesses, in explaining why they do not believe confusion is likely, do not rely on any differences in the marks. Rather, they point to the differences in the specific goods of the parties, and the differences in the parties' actual channels of trade and customers, points which we have previously discussed.

Applicant has also argued, albeit in connection with a different du Pont factor, that it always uses its house mark in connection with its goods. Whether or not, as applicant states, it will continue to use BIOTONE along with DUAL-PURPOSE MASSAGE CREME, our determination of likelihood of confusion must be based on the mark for which application is sought.

With respect to the two factors regarding actual confusion, the record is clear that there have been no instances of actual confusion, despite eighteen years of contemporaneous use. However, this is likely due to the

¹⁸ As noted previously, applicant's application never encountered a refusal on the ground of mere descriptiveness, nor was this raised by opposer as a ground for opposition. However, whether or not the hyphenated term DUAL-PURPOSE is merely descriptive, the word DUAL clearly has a meaning of "relating to two."

limited trade channels in which applicant's goods are sold, and the specialized group of customers to which it actually markets its goods. Because applicant seeks to register its mark without such limitations, and may therefore sell its goods to the public at large in general consumer retail outlets, the lack of confusion in the past is not an indication that confusion is not likely to occur in the future. Thus, we regard these du Pont factors as neutral.

Opposer uses its mark on both moisturizers and cleansers, and has in the past used it for hair shampoo. To the extent that the factor of the variety of goods on which a mark is or is not used favors either party, it favors opposer.

In connection with the du Pont factor of market interface, applicant has argued in its brief that opposer is guilty of laches because opposer "has admitted to have known about Applicant's marketing a massage cream under the trademark in issue at least as early as August 1998" but that, "except for filing this opposition proceeding in 2001, Opposer never even sent a warning to Applicant to the effect that Opposer objects to Applicant's use of the DUAL PURPOSE MASSAGE CRÈME MARK." p. 32.

Applicant relies, as support for its claim, on opposer's answer to an interrogatory as to when opposer first became aware of applicant's use of the mark DUAL-

Opposition No. 91122373

PURPOSE MASSAGE CREME. However, applicant misstates opposer's "admission." Opposer merely stated that it had successfully objected to applicant's prior application, Serial No. 75500487 for the mark DUAL PURPOSE, which had been filed in June 1998. The application, in fact, was not published for opposition until May 25, 1999, and opposer, as indicated in its interrogatory response, opposed that application. Thus, opposer clearly let applicant know, by its opposition to the DUAL PURPOSE application, that opposer had an objection at least to applicant's use of DUAL PURPOSE for, inter alia, massage creams.

The mark which is the subject of the current proceeding was published for opposition on September 26, 2000 and, after obtaining extensions of time, opposer filed the instant opposition on March 26, 2001. Because laches begins to run from the time the plaintiff could take action against the registration of the mark, i.e., the date the mark is published for opposition, and because, by the very nature of an opposition proceeding, an opposition represents the prompt taking of action, there can be no laches in these circumstances. See *National Cable Television Association Inc. v. American Cinema Editors Inc.* 19 USPQ2d 1424, 937 F2d 1572 (Fed. Cir. 1991).

The du Pont factor of market interface is neutral.

We also consider the factor of "the extent to which applicant has a right to exclude others from use of its mark on its goods" to be neutral. Because du Pont involved an ex parte proceeding, the reference in that case was to the applicant's rights, but we have considered opposer's rights here as well. As previously indicated, opposer's mark PURPOSE is not such a strong mark that opposer can exclude others from all uses of the word PURPOSE for their goods. For similar reasons, applicant's mark is not a strong mark. On the contrary, although the issue of mere descriptiveness of this mark is not before us, we must consider applicant's mark to be at the very least highly suggestive.

As for whether the extent of potential confusion is de minimis or substantial, the record does not indicate the extent to which members of the general public purchase massage creams, and would therefore be exposed to both applicant's and opposer's products. Therefore, we regard this factor as neutral.

After considering all of the evidence, we find that applicant's use of DUAL-PURPOSE MASSAGE CREME for massage creme is likely to cause confusion as to source with opposer's mark PURPOSE for moisturizers. In reaching this conclusion, we have kept in mind that any doubt on the issue of likelihood of confusion must be resolved in favor of the prior user and registrant. See San Fernando Electric Mfg.

Opposition No. 91122373

Co. v. JFD Electronics Components Corporation, 565 F.2d 683, 196 USPQ 1 (CCPA 1977); Mobil Oil Corporation v. Teagarden, 190 USPQ 560 (TTAB 1976).

Finally, we wish to make clear that we have not given any weight to opposer's contention that applicant adopted its mark in bad faith. As is clear from the testimony of applicant's witnesses, neither the person who chose the mark or anyone connected with applicant had heard of opposer's PURPOSE products and mark at the time DUAL-PURPOSE MASSAGE CREME was selected or, indeed, until opposer filed an opposition to applicant's application for DUAL PURPOSE.

Decision: The opposition is sustained.¹⁹

¹⁹ As indicated previously, if applicant were to appeal this decision and ultimately prevail, the application will be remanded to the Examining Attorney under Trademark Rule 2.131 to consider whether a disclaimer of MASSAGE CREME should be required.